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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/976,579 11/24/97 THORNTON

J JAO-34191

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EXAMINER

TUCKER, C

ART UNIT

PAPER NUMBER

2766

DATE MAILED:

08/19/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/976,579

Applicant(s)
Thornton et al.

Examiner
Christopher M. Tucker

Group Art Unit
2766



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-27 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-27 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☒ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 10-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not sufficiently recite how the token generating means would generation said tokens. The applicant only states on page 7 line 33 - page 8 line 8 that the tokens are generated and encoded, for example, on a programmed general purpose computer.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-27 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wolff et al. (U.S. 5,671,282).

As per claims 1 and 10, Wolff et al. disclose a system and method for producing a paper document, comprising:

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an encoder that encodes information about the document (e.g., information in the human readable portion) into digital machine readable form and may include a unique identifier, version number, date, and other relevant information (column 3 lines 35-41; column 4 lines 23-27; column 5 lines 50-53);

a printer that prints the encoded information onto the document (column 4 lines 16-20; column 5 lines 44-46).

Wolff et al. do not explicitly disclose a token generator that generates tokens relating to at least one other electronic document. However, they do recite the above mentioned machine readable form that was print out by the print engine of the server subsystem (column 4 lines 16-20). The information that was encoded in machine readable form has both parts which the applicant attributes to a token: the reference and the access information (page 2 lines 10-11 of applicant's disclosure). The information that was encoded in machine readable form comprises information about the author, descriptions, or tracking information (column 5 lines 50-63). Therefore, the information that was encoded in machine readable form is inherently identical to a token, or in the alternative, it would have been obvious to one of ordinary skill at the time of applicant's invention to use a token since they both serve the same purpose and effect the same end result.

As per claims 2 and 11, Wolff et al. disclose an electronic scanner for scanning the encoded information (column 5 lines 5-24).

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As per claims 3 and 12, Wolff et al. disclose recognition software/hardware to interpret information on the document (column 5 lines 9-24).

As per claims 4 and 13, Wolff et al. disclose that the unique identifier and additional information contained in the machine readable portion allows the document and relevant information to be retrieved from memory (column 3 lines 35-50).

As per claims 5 and 14, Wolff et al. disclose the printer to print human readable identifiers relating to the printed information that was encoded in machine readable form on the paper document (column 3 line 36-39).

As per claims 6 and 15, Wolff et al. disclose a memory for storing the electronic form of the document and descriptions and tracking information for the document (column 3 line 65 - column 4 line 2).

As per claims 7 and 16, Wolff et al. disclose that the encoded information may contain information relating to the current holder of the document (column 5 lines 50-63).

As per claims 8 and 17, Wolff et al. disclose that the encoder encrypts the machine readable information (column 4 lines 29-30).

As per claims 9 and 18, Wolff et al. disclose that the machine readable information contain authentication information which is specific to the document allowing it to be tracked and hence authenticated (column 3 lines 27-34).

As per claims 19-27, this method comprises the same limitations as in claims 1-9.

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Tucker whose telephone number is (703) 306-5539.

CMT
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August 12, 1999

Gail Hayes
GAIL O. HAYES
SUPERVISORY PATENT EXAMINER
GROUP 2700